## REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed July 7, 2005. Having addressed all objections and grounds of rejection, claims 1-25, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

Claims 1-25 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Applicants acknowledge this provisional rejection but deem that a response is premature in that none of the rejected claims has been found patentable over the prior art of record. At such time as claims 1-25 have been otherwise found allowable, Applicants will make an appropriate response to this provisional rejection if still pending.

The Examiner has rejected claims 1-25 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,721,727, issued to Chau et al (hereinafter referred to as "Chau"). This ground of rejection as to the amended claims is respectfully traversed for the reasons provided below.

The standard for the finding of anticipation during the examination process may be found in MPEP 2131, which states in part:

> TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
> EVERY ELEMENT OF THE CLAIM

9

"A claim is anticipated only if each and every element <u>as set forth in the claim</u> is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "<u>The identical invention must be shown in as complete detail as is contained in the ... claim</u>." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection of claims 1-25, as amended, as being anticipated by Chau is respectfully traversed because "each and every element <u>as set forth</u> in the claim[s] is" **not** "found, either expressly or inherently described" in "as complete detail as is contained in the claims" within Chau.

The essence of Applicants' invention as disclosed and claimed includes a "legacy database management system" coupled to a "publicly accessible digital data communication network" (e.g., the Internet) wherein the communication is in the form of "XML messages" which need conversion to the "command language" of the "legacy database management system" to permit honoring of service requests. As explained extensively throughout Applicants' specification, the present invention is needed, because the "service request" and/or data to be operated upon are transferred in XML protocol which is **incompatible** (see page 5, line 21, through page 6, line 1) with the internal format of the "legacy data base management system".

The system of Chau, on the other hand, is directly compatible with XML documents. Fig. 2 specifically shows storage

10

of XML Files 208. In fact, the purpose of Chau is handling XML documents within a database. The Abstract of Chau begins: "A technique is provided for creating metadata for fast searching of XML documents". Independent claims 1, 6, and 11 have been herewith amended to more explicitly state the nature of this distinction by making it clear that the claimed "legacy data base management system" is **incompatible** with XML document protocol. That is because the claimed "legacy data base management system" was designed before the advent of XML document protocol.

To find anticipation in accordance with MPEP 2131, not only must the elements of the claim be found in a single reference, they must be found "**as set forth in the claim**". That means the claim elements found in the reference must be coupled and cooperate as "**as set forth in the claim**". This requirement is only a matter of common sense. Otherwise, all claims would be anticipated by a dictionary, which contains all of the words of the claim, without being "**as set forth in the claim**". Though many of the claimed elements are not found in Chau, to the extent the Examiner has applied the reference to claim elements found in Chau, it is readily apparent that he has neglected the obligation to show that these claim elements are "**as set forth in the claim**", as required by MPEP 2131.

With regard to the rejection of claim 1, for example, even before the present amendments, an XML service was required to be honored by the claimed "legacy data base management system". In other words, claim 1 required the claimed "legacy data base management system" to operate on the incompatible XML document. In making the rejection, the Examiner cites material from Chau showing a simple mapping of a received XML document into storage. Claim 1, as amended, now makes it more explicit that the claimed "legacy data base management system" is required to operate on an otherwise incompatible XML document in response to an XML service request generated by the claimed "user terminal". This structure is simply not found within any of the prior art of record.

Because the disclosure of Chau cannot comply with the requirements of MPEP 2131 for finding anticipation, the rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claims 2, 8, 13, and 19 depend from claims 1, 7, 12, and 18, respectively. Therefore, these claims contain all of the limitations from the claims from which they depend and are further limit the claimed XML service. In making his rejection, the Examiner cites Chau column 3, lines 15-21, which simply describes the contents of an XML message as "data". This does not correspond to the claimed invention which is concerned with the contents of an XML message as a service request. As clearly

defined by Applicants at page 5, line 4, "service" is equivalent to data base management functions". In other words, claims 2, 8, 13, and 19 further limit the claimed XML message which is not a description of data (as in Chau), but a description of data base management functions to be performed. Chau simply does not address the manner, if any, for a user to request and specify needed data base management functions. The rejection of claims 2, 8, 13, and 19 is respectfully traversed.

Claims 3, 14, and 20 depend from claims 2, 13, and 19, respectively, and further limit the XML service to comprising "a plurality of tables". In making his rejection, the Examiner again cites column 3, lines 15-21, of Chau. As explained above, this citation relates to handling an XML document handling data. It has nothing to do with the claimed request for the performance of specified data base management functions. The rejection of claims 3, 14, and 20 is respectfully traversed.

Claims 4 and 15 depend from claims 3 and 14, respectively, and further limit the XML service to comprise "executable script". In other words, the claimed invention transfers an XML document containing "executable script". There is no suggestion anywhere in Chau that there is any transfer of "executable script" within an XML document or otherwise. The rejection of claims 4 and 15 is respectfully traversed.

Claims 5 and 10 depend from claims 4 and 9, respectively, and further limit the claimed network which couples the claimed "user terminal" to the claimed "legacy data base management system". Chau does not have the limitations of claims 4 and 9 from which claims 5 and 10 depend. Therefore, Chau cannot have these further limitations. The rejection of claims 5 and 10 is respectfully traversed.

Claim 6, as amended, is an independent apparatus claim having four basic elements. The second element is the "data base management system having an internal format different from XML". As if to admit that Chau does not meet this limitation, the Examiner cites column 7, lines 66-67, stating, "an XML column is used to store **entire XML documents** in **native XML format**". Thus, Chau has an "internal format" specifically the same as XML.

The third element, is limited by "a facility which generates an input service". As explained above, Chau does not teach generation of a "service". It is unknown whether Chau has the functionality of a data base management system for operating on data, because it is not mention by Chau.

The final claim element is limited by "a converter....". Chau does not need this element, because Chau is not incompatible with XML documents as explained above. The rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claims 7 and 18 depend from claims 6 and 17, respectively, and further limit the "input service" to an "XML input service". As explained above, Chau has no "input service". As a result, the Examiner cites column 7, line 66, through column 8, line 5, of Chau, which discusses unpacking of an XML document. The rejection of claims 7 and 18 is respectfully traversed.

Claims 9 and 25 depend from claims 8 and 24, respectively, and further limit the claimed "facility" to comprise "a plurality of sample XML messages". The Examiner again cites column 3, lines 15-21, which is legally irrelevant, because it does not address the claimed invention. The rejection of claims 9 and 25 is respectfully traversed for failing to meet the requirements of MPEP 2131.

Claim 11 is an independent method claim having four basic steps. The essence of this claim is the preparation of a service request from a user terminal. Claim 11 has been slightly amended to make this more explicit.

The first step requires "retrieving a sample document from a repository of said legacy data base management system". Chau has no "sample document", has no "repository", and has no "legacy data base management system". Therefore, the Examiner cites column 8, lines 15-21, and column 44, lines 40-45, of Chau. Neither of these citations say anything of the claimed "sample document", the claimed "repository", or the "legacy data base

management system". Apparently, the closest that Chau comes to this limitation is expressed by the Examiner as:

(i.e., the XML system supports legacy flat files)
Surely, the Examiner does not equate this statement with the claimed "legacy data base management system". These citation are legally irrelevant, because they do not address the claimed invention.

The second step of claim 11 requires "editing". There is simply no mention of "editing" to be found within Chau. Again, instead of admitting this lack of teaching by Chau, the Examiner cites copious amounts of text to obscure the fact that Chau does not have the claimed "input service request".

Furthermore, Chaus does not have the claimed "converting" or "presenting" steps, because Chau does not have an "input service request" within an XML document. The rejection of claim 11, and all claims depending therefrom is respectfully traversed.

Claim 12 depends from claim 11 and further limits the "sample document". Because Chau does not have the claimed "sample document" as explained above, it cannot have the claimed "XML sample document". The rejection of claim 12 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. Chau has no "sample input service". Therefore, not surprisingly Chau has no "means for storing a

sample input service". Therefore, the Examiner cites column 7, lines 66-67, of Chau and explains:

(i.e., an XML column is used to store entire XML documents in the native XML format)

It is baffling why the Examiner considers this relevant to the claimed element. The claimed "storing means" is a piece of hardware. Surely, the Examiner can distinguish between a piece of hardware called "storing means" and a logical construct called "an XML column". Secondly, the element requires "means for storing a **sample input service**". Chau does not teach a "sample input service".

Similarly, because Chau does not have the claimed "sample input service", it cannot have the claimed "retrieving means" or the claimed "editing means". Furthermore, Chau has no "providing means" because it has no "legacy data base management system". Having none of the other structure, it cannot have the claimed "transferring means". The rejection of claim 16, and all claims depending therefrom, is respectfully traversed.

Claim 17 depends from claim 16 and further limits the "storing means". Because Chau does not have the "storing means", it cannot have these further limitations. The rejection of claim 17 is respectfully traversed.

Claim 21 is an independent apparatus claim having three basic structural elements. The first element is a "user terminal.....". In finding this element, the Examiner cites Chau

17

column 8, lines 15-21, and column 44, lines 40-45. These citations say nothing of a user terminal. Even more confusing is the Examiner's statement:

(i.e., the XML system supports legacy flat files)

Surely, the Examiner does not equate the support of "legacy flat files" with the claimed "user terminal". Thus, the Examiner's legally irrelevant citation does not mention a "user terminal".

The second element is a "converter.....". Because Chau does not have "a data processing service request", it does not need the claimed converter. Therefore, the Examiner again cites column 3, lines 15-21, of Chau which involves only unpacking of data. The cited text does not address the claimed requirements of "an ordered sequence of native command language statements and a plurality of input parameters". Therefore, Chaus does not have the claimed "converter" in accordance with the requirements of MPEP 2131.

The third element is limited by a "legacy data base management system". As explained above, this is not found in Chau. Therefore, the rejection of claim 21, and all claims depending therefrom, is respectfully traversed.

Claim 22 depends from claim 21 and further limits the "legacy data base management system". The Examiner cites column 11, lines 28-34, of Chau, which even though it mentions a "mainframe computer", does so in the context of admitting that

18

such an embodiment is not disclosed.   The rejection of claim 22 is respectfully traversed.

Claim 23 depends from claim 22 and further limits the software architecture of the "user terminal".   Not only does Chau not have the claimed "user terminal" as discussed above, the cited Fig. 1 says nothing about software architecture.   Whatever is shown in Fig. 1 might be Macintosh, IBM 360, etc.   The rejection of claim 23 is respectfully traversed.

Claim 24 depends from claim 23 and is further limited by a "repository for storage of said ordered sequence of statements of said native command language prior to execution".   Because Chau does not have the claimed "ordered sequence.....", it cannot have the claimed "repository".   The Examiner's citations in support of his rejection are legally irrelevant on their face, because they do not address the claimed invention.   The rejection of claim 24 is respectfully traversed.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to
Deposit Account No. 14-0620.

Respectfully submitted,

Thomas N. Turba et al.

By their attorney,
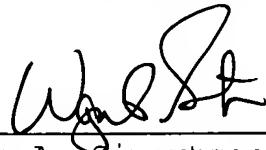
Date __Oct 7__ , 2005

Wayne A. Sivertson
Reg. No. 25,645
Suite 401
Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
55413
(612) 331-1464

20